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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,719	06/19/2002	Takako Fujii	M2096-4	5004

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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER

KOKABI, AZADEH

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,719

Applicant(s)

FUJII ET AL.

Examiner

Azy Kokabi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-9,13,14 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9,13,14 and 25-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Abstract

1. The abstract of the disclosure is objected to because it contains two paragraphs. The abstract should be limited to one paragraph. Correction is required. See MPEP § 608.01(b).

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 31 and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,186,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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both claims are directed to a protective clothing or garment for the regions of the lower leg having a strong straining force.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-3, 13, 27, 29, 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-12412.

JP '412 shows a garment which covers the lower body of a user (see figure 1), and has a crotch part (#11). The garment is worn by being fitted to the wearer's body (see figure 1). The garment has a strong straining force portion (see generally at #4), which is at a position on the back side of the garment corresponding to any region from the os sacrum to vertebrae lumbalis. A strong straining portion (#7) extends from the trochanter major toward region femoralis anterior medialis through at least the hamstring (see figure 1).

Furthermore, JP '412 shows a strong straining portion (see generally at #6) corresponding to musculus rectus abdominis in the hypogastric region. The strong straining portion (#6) extends downward from the position on musculus rectus abdominis in hypogastric region approximately in the direction of muscle fibers of musculus obliquus internus abdominis at right and left to at least the vicinity of trachanter major. Figures 1 and 2 of the JP'412 device show another straining portion (see generally at #9) which extends from the vicinity of the back center of the waist through musuculus latismus dorsi and musculus gluteus medius at right and left.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '412.

As previously, discussed in paragraph 5 above, JP '412 further discloses all the limitations as set forth, however, JP'412 fails to disclose the straining force of the portion or the type of fabric chosen.

However, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided for a tricot or raschel fabric, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (CCPA 1960).

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a straining force of 150 to 400gf, since it has been

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held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (see MPEP 2144.05). The amount of straining force would depend on the amount of support needed for individual users.

9. Claims 7-9, 14, 25-26, 28, 32, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '412 in view of WO98/21987.

As previously, discussed in paragraph 5 above, JP '412 further discloses all the limitations as set forth, however, JP'412 fails to disclose straining portions that cover the abdomen region.

WO'987 discloses a garment having a portion (#31) that covers the hypogastric region and is connected to two strong straining portions (#32 and #33). The garment has an abdominal straining portion in order to correct abdominal and gluteal functions (see title). The WO'987 device appears to be a united and continuous structure. The abstract discloses that the garment comprises a stretch fabric and covers the lower body of a wearer, has a crotch part, and is a girdle.

In view of WO'987, it would have been obvious to one of ordinary skill in the art to have provided a girdle having an abdomen straining portion in order to correct abdominal functions and to support the abdomen area.

10. Claim 33, 34, 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '412 in view of Tanaka (U.S. Patent NO. 5,640,714).

As previously, discussed in paragraph 5, JP '412 discloses all the limitations as set forth, however, JP '412 fails to disclose the method of forming a strong straining portion.

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Tanaka discloses a protective garment which as a strong and weak straining forces. The garment of Tanaka is used to provide protective support to the region of the lower leg. The garment can be easily produced by forming a base material of the protection garment main body with a material with a weak straining force, and fixing a material with a strong straining force to the surface and/or the underside of the base material in the necessary region by an appropriate means such as stitching or adhesion without the complicated, time consuming operation of alternately seaming a portion with a weak straining force and a portion with a strong straining force (see at least column 6, lines 7-23). In reference to claim 35, see at least column 11, lines 55-68 to column 12, lines 1-16.

Therefore, in view of Tanaka, it would have been obvious to have laminating the strong straining portion onto the main body of the fabric in order to produce garment in a cheap and efficient manner. Furthermore, it would have been obvious to have provided strong straining forces on the portion of the lower leg in order to accommodate a user that needed protection that extended from the abdomen area to the lower leg region.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references cited disclose various features, which are similar to those disclosed by Applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azy Kokabi whose telephone number is (703) 306-4154. The examiner can normally be reached on Monday- Friday, 6:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AK



Henry Bennett
Supervisor Patent Examiner
Group 3700